

Protecting Trademarks in the New Domains

by Scott M. Hervey

The Internet is just about to go through a very large growth spurt. On November 16, 2000, the Internet Corporation for Assigned Names and Numbers (ICANN) selected seven new generic top level domains (gTLD) that will be made available for registration. These new gTLDs (.biz, .info, .pro, .name, .aero, .museum, .corp) will be in addition to the existing .com, .net and .org gTLDs.

Some of the new gTLDs are restricted by their very nature. The new gTLD .aero is restricted to individuals or corporations in the air transportation industry, while .pro is only available to accountants, lawyers and physicians. Likewise, the new gTLDs .corp and .museum are solely intended to be used by cooperatives and museums, respectively. The remaining gTLDs, .biz (for use by businesses), .info (no restriction on use), and .name (for registration by individuals), are the least restricted and most open to registration by the general public.

With the approval of the new domains, ICANN commenced negotiating accreditation agreements with the new gTLD registries. As part of these negotiations, ICANN required the registries to implement a policy and procedure to reduce the potential for cybersquatting and allow trademark owners the ability to protect their intellectual property rights.

As of May 15, 2001, ICANN finalized the accreditation agreements with the .biz and .info registries. The accreditation agreements involving the .pro and .name registries are close to being complete. The registration procedures for these four new gTLDs are somewhat different, but each provides existing trademark owners with the ability to protect their marks in this new cyber frontier.

.BIZ

Beginning on May 21, 2001 and continuing through early July 9, 2001, the .biz registry will offer an "intellectual property claim service" for businesses and individuals. This service allows a mark owner to submit an ownership claim to a trade or service mark before the application process opens up to the general public. Such a claim will not guarantee the mark owner a .biz domain name reflecting the mark; like all other applicants, the mark owner must file a standard domain name application after the intellectual property claim phase runs. However, a mark owner's claim will be used to notify potential cybersquatters and other potential infringers of the mark owner's assertion. Once notified of the claim, the prospective registrant is required to acknowledge the claim before the registration process can be completed.

After acknowledgment of the claim, a 30-day hold is put on the registration of the domain name in order to give the mark owner an opportunity to challenge the registration using an administrative dispute resolution process unique to the .biz registry. This domain name dispute resolution process is available only to those who file claims during the claim service phase. After the claim service phase runs, no additional claims will be accepted.

.INFO

The process for the .info gTLD is somewhat different. The .info registry offers a simpler "sunrise" period. During the sunrise period, owners of trademarks and service marks registered as of October 2, 2001 are given an advance opportunity to register a .info domain name. The domain name must be identical to the text or word portion of the trade or service mark.

The sunrise period will last for approximately 30 days. During the sunrise period, the registry will conduct registrations in five rounds. At the end of each round, the domain name applications will be randomly processed for registration. In the event that separate applicants submit registration requests for identical trademarks, the first request to be processed by the registry that meets the criteria for a sunrise registration will be awarded the domain name. A sunrise domain will only be registered for a term of a minimum of five years and up to a maximum of ten years.

The .info registry also offers a dispute resolution process for domain names registered during the sunrise period. This resolution process is called the sunrise challenge process. The sunrise challenge process will be available during the sunrise challenge period, which begins at the end of the sunrise period and continues for 120 days. During the sunrise challenge period, a third party can challenge a sunrise domain by filing a claim with the World Intellectual Property Association. After the sunrise challenge period ends, the validity of a sunrise domain name, or other domain name registered in the .info gTLD, can only be challenged through ICANN's Uniform Dispute Resolution Policy or the court system.

.PRO

Like the .info domain, .pro will also utilize the sunrise period concept. The sunrise period will last 15 to 30 days. During this time period, holders of a mark registered as of March 31, 2001 will be able to register a .pro domain name matching their mark. This trade or service is further conditioned upon the sunrise registrant being a "qualified professional".

A .pro domain name may only be registered by a qualified professional. Initially, only physicians, accountants and lawyers will be entitled to register a .pro domain name. Professional organizations and professional corporate divisions will also be entitled to register a .pro domain name. The potential registrar of a .pro domain name must provide proof of qualification as a .pro professional before the .pro domain name will be registered.

Another unique feature of a .pro domain name is that each name contains an extension identifying the owner's field of practice. For example, my .pro domain name would be scotthervey.law.pro. If I were a doctor, my domain name would be scotthervey.med.pro.

.NAME

Only personal names can be registered as a .name domain. Although a .name domain is primarily intended to be a space for people and private individuals, the registry has implemented safeguards to protect the intellectual property rights of third parties.

Like the .info and .pro registries, the .name registry will utilize a sunrise period where holders of registered trade or service marks can pre-register a domain name reflecting their mark. In addition, the .name registry provides "defensive registrations" which effectively set up a barrier against registrations in the covered area.

Defensive registrations can take the following forms: (1) Covering the absolute domain name in the same form as a personal name (i.e. product.newco.name); (2) On the second level (i.e. newco.name); and (3) On the third level (i.e. newco.<*>.name), where <*> is any second level domain name.

A defensive registration on the second level (i.e. "newco.name") will prevent not only "newco.name" from being registered, but will also prevent "<*>.newco.name" from being registered. A defensive registration on the third level, (i.e. "product.<*>.name") will not only prevent "product.<*>.name" from being registered, but will also prevent the registration of "product@<*>.name" as an email registration.

Defensive registrations will be available during the sunrise period. Defensive registrations will also be available after the .name domain is made available to the general public. The fees to register a second or third level defensive registration will be upwards of \$2,000, while the fee to register an absolute defensive registration will range from \$250 and up.

The Bottom Line

Even though the new domain name registries are expecting what can only be described as a land rush of registration applications, trademark owners still have time to shore up their property rights. However, if mark owners fail to act quickly, their rights may be trampled over in the stampede that is sure to follow.